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PATENT APPLICATION
Attorney's Docket No.: 1159.1004-003 (SAB92-01A2A)

A. Lawrence #9 9.13.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Steven A. Bogen and Herbert H. Loeffler

Application No.: 09/205,945 Group: 1743

Filed: December 4, 1998 Examiner: M. Wallenhorst

For: Dispensing Assembly With Interchangeable Cartridge Pumps

DO NOT ENTER

OK TO ENTER

OK AS ENTERED

MW 9-18-00

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office:
on 9-11-00 (Date) Claire J. Handelman (Signature)
CLAIRE T. HANDELMAN
Typed or printed name of person signing certificate

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The undersigned thanks Examiner Wallenhorst for her courteous telephone interview with the undersigned today.

The only outstanding rejection in this application is with respect to double patenting. In the Advisory Action dated August 29,2000, the Examiner indicated that a Terminal Disclaimer was still required. In the telephone interview, page 800-15 of the M.P.E.P., the paragraph bridging the first and second columns, was noted. A copy of that page is attached. In view of that section, it is requested that the double patenting rejection be withdrawn from this application, the application with the earlier priority date.

In view of the cited M.P.E.P. section, reconsideration of the Advisory Action of August 29, 2000 is requested. If the application is not in condition for allowance, the Examiner is asked to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By _____
James M. Smith, Esq.
Registration No. 28,043
Telephone (781) 861-6240
Facsimile (781) 861-9540

Lexington, Massachusetts 02421-4799
Dated: 9/11/00

[redacted]

I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

A double patenting issue may arise between two or more pending applications, between one or more pending applications and a patent, or in a reexamination proceeding. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

A. Between Issued Patent and One or More Applications

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

B. Between Copending Applications—Provisional Rejections

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or that are filed by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

C. Reexamination Proceedings

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the Commissioner authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, "Congress intended that the phrases 'patents and publications' and 'other patents or publications' in section 303(a) not be limited to *prior art* patents or printed publications." (emphasis added)). Accordingly, if the issue of double patenting was not addressed during original prosecution, it may be considered during reexamination.

II. REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121.

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 – the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ...." Thus, the term "same inven-

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
Two Militia Drive
Lexington, MA 02421-4799

Telephone: (781) 861-6240 Facsimile: (781) 861-9540

FACSIMILE COVER SHEET

To: **Examiner:** M. Wallenhorst Group: 1743

Date: September 11, 2000

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From: James M. Smith, Esq.

Subject: **Paper:** Request for Reconsideration
Docket No.: 1159.1004-003 (SAB91-01A2A)
Applicant: Steven A. Bogen et al.
Serial No.: 09/205,945
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Please confirm receipt of facsimile: Yes ___ No ___

Comments:

URGENT